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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,351	09/12/2003	Peter Ellington	MRKS/0126	1597

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EXAMINER


NICHOLSON, ERIC K

ART UNIT PAPER NUMBER

3679

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 <b>Office Action Summary</b>	<b>Application No.</b> 10/663,351	<b>Applicant(s)</b> ELLINGTON ET AL.	
	<b>Examiner</b> Eric K Nicholson	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/13/04 2/16/04</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### Claim Rejections – 35 USC § 112

Claims 18 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 18 it is unclear what is meant by “adapted to be energized”. In claim 19 it is vague and indefinite as to how or what material properties are select to facilitate movement between flanks during expansion.

### **Claim Rejections – 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,8-11,15,16,19 and 24-28 rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 4,113,290 to Miida. See male threaded pin member 3 and female threaded pin member 2 as shown in fig. 4 wherein some flanks are engaged and some flanks are gapped. It is noted that the Miida coupling is not stated to be expanded however it is the examiner's position that it is clearly “expandable” as claimed. The examiner finds no distinction, and applicant has provided no distinction, between a threaded connection and one that is to be

expanded or is expandable. Such matters are considered to be a matter of intended use in the product claims and as such do not patentably define over the prior art. As to claim 11 see column 3, lines 55-60.

Claims 1-5,8-19,21 and 23-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 6,158,785 to Beaulier et al.. See male threaded pin member 30 and female threaded pin member 130 as shown in fig. 12 wherein some flanks are engaged and some flanks are gapped. It is noted that the Beaulier et al. coupling is not stated to be expanded however it is the examiner's position that it is clearly "expandable" as claimed. The examiner finds no distinction, and applicant has provided no distinction, between a threaded connection and one that is to be expanded or is expandable. Such matters are considered to be a matter of intended use in the product claims and as such do not patentably define over the prior art. As to claims 17 and 18 see claim 7 of Beaulier et al.. As to claims 23 and 24 see column 7, lines 1-5.

### **Claim Rejections – 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6,7,20 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,113,290 to Miida in view of WIPO patent WO02/01102 and applicant's admitted prior art in the specification on pages 1-2.. As noted above the Miida coupling discloses the claimed device except the threaded connection is not expanded. The WIPO coupling and applicant's disclosure of prior art on pages 1-2 of the specification discloses that it is known in the art to expand threaded pipes or casing joints for various reasons using either rotary expansion tools, solid cone expansion tools or hydraulic expansion tools. It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the threaded coupling of Miida as needed as taught by the WIPO patent and applicant's disclosure on pages 1-2 of the specification in order to provide a more secure coupling for the threaded coupling to reinforce worn casing or reduce the required diameter of the drilled hole for a final casing hole diameter.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note **EP patent 0803637** and **GB 2161569** which also illustrate features of the present invention.

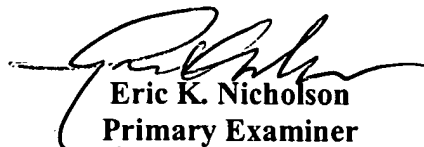
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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1-21-05

  
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